

REMARKS

The Office Action mailed June 9, 2004 has been received and the Examiner's comments carefully reviewed. Claims 1, 9, and 20 have been amended; the amendments are supported at page 7, lines 18-20, and at Figure 2. Accordingly, no new matter has been added. Claims 1-22 are currently pending in this application. Applicants respectfully submit that the pending claims are in condition for allowance

I. Obviousness Rejections

Claims 1-11, 13-15, and 18-20 were rejected under 35 U.S.C. § 103(a) as being obvious over Ruppert et al. (U.S. 2,236,969) ("Ruppert") in view of Ishikawa et al. (U.S. 5,590,407) ("Ishikawa"). This rejection is traversed.

Independent claims 1, 9, and 20 relate to a programmable headset that includes, among other things, a user-activated control device for switching a frequency of the transmitter between at least a first frequency and a second frequency, thereby enabling the headset to switch between communicating with a first lane location using the first frequency and a second lane location using the second frequency. The remaining pending claims depend from and further limit the above independent claims, therefore, they also incorporate the above limitation.

As noted in the Office Action Ruppert fails to disclose the above-recited subject matter.

A. The combination of the references does not include all the features of the claimed invention

Applicants assert that there is no motivation to combine the cited references, as discussed in more detail below in Section I.B. In addition, even if Ishikawa were combined with Ruppert, the resulting headset would not include an control device used to switch the transmission frequencies of the headset. Ishikawa discloses a system including a first headset 136 that communicates with a lane A and a second headset 151 that communicates with a second lane B. Each headset includes a switch 139 and 149 (both of which are referenced in the Office Action at page 5, line 1) that is preset to a particular channel. See Ishikawa at column 15, lines 18-20; and column 16, lines 10-12.

Ishikawa fails to disclose or suggest that the lane change switches 139 and 149 are user-activated. On the other hand, Ishikawa specifies that other switches are user controlled or

detector controlled. For example, switches 7, 8, 10, 23, 212, 209, and 210 are specified as being detector controlled. See Ishikawa at column 3, lines 44-45; column 4, lines 39; column 6, lines 17-23; and column 7, lines 11-13. Conversely, switches 30, 32, and 240 are specified as being user controlled (i.e., manually operated). See Ishikawa at column 3, lines 20-28; column 4, lines 17-19; column 5, lines 10-12. Nonetheless, the only disclosure with respect to the lane change switch 139 and 149 is that lane change switch 139 of headset 136 is in a position corresponding to the drive through lane A and lane change switch 149 of headset 151 is in a position corresponding to the drive through lane B. See Ishikawa at column 14, lines 42-47.

With respect to prior art lane change switches 239 and 249, Ishikawa similarly discloses that they are "previously set" so that each headset corresponds to a particular lane. See Ishikawa at Figures 3 and 4, and at column 7, lines 35-36. Nowhere does Ishikawa disclose or suggest that lane change switches 139 and 149 are different than those of the prior art 239 and 249. As such, it appears that the lane change switches disclosed in Ishikawa 139, 149, 239 and 249 are not user-activated and are set prior to the final assembly of the headset. In any event, Ishikawa clearly fails to disclose that the lane change switches are external.

B. There is no motivation to combine the cited references

As indicated above, Applicants also traverse on the grounds that the Examiner has not identified a reason, suggestion, or motivation *in the prior art* that would cause a person of ordinary skill in the field of the invention to combine the two references. The Office Action merely asserts that the motivation for modifying Ruppert to include some of the features disclosed in Ishikawa is that the resulting device would include all the features of the present invention. See Office Action mailed June 9, 2004 at page 5, last sentence.

The above-asserted motivation relies completely on improper hindsight. In particular, the asserted motivation is improperly based on Applicants' disclosure rather than the prior art. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (both the suggestion to combine and the reasonable expectation of success must be found in the prior art rather than the applicant's disclosure). Since a proper *prima facie* case of unpatentability has not been set forth, Applicants are entitled to withdrawal of the rejection. See In Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (reversing the claim rejections on the grounds that the Examiner's reason for combining references to support an obviousness rejection was improperly derived from

applicant's invention rather than the prior art; in particular, because a person would not reasonably be expected to look for a solution to the particular problem facing the inventor in the art fields in which the references were cited.) Accordingly, the asserted reason for the combination in the outstanding Office Action does not support the combination of the cited references. As such, the rejection should be withdrawn.

Applicants further submit that the prior art does in fact lack any reason, suggestion, or motivation that would cause a person of ordinary skill in the field of the invention to combine Ishikawa with Ruppert. Ruppert is directed at a hands free headset wireless telephone. The wireless telephone includes a headset 10 that communicates via radio frequencies with a base station 70, which is connected to an office or landline telephone system. See Ruppert at column 2, lines 7-10. The base station 70 connects to the telephone network via conventional telephone wires and jacks thereby serving as a conduit for one or more of the headsets to interface with the telephone system. See column 7, lines 27-33; column 6, lines 17-20; and Figure 5.

Notwithstanding whether the Examiner's premise that the base station 70 of Ruppert is equivalent to the lane location of the present invention, there is no reason, suggestion, or motivation in the prior art to modify Ruppert to include a user activated control device for switching between a first and second frequency to enable the headset to communicate with two different base stations. In view of Ruppert, it appears that such functionality would at best be duplicative since two separate connections to the same telephone network provides no apparent advantages. As such, Ruppert teaches away from such a combination.

Applicants further submit that switching the principle reference relied upon in the Office Action from Ruppert to Ishikawa does not change the fact that there is no reason, suggestion, or motivation in the prior art to combine the references. Ishikawa is directed at a wireless order taking system. Nowhere in Ishikawa is there any suggestion to combine its radio frequency based headset ordering system with a wireless telephone system. Likewise, there is no suggestion in Ruppert to use wireless telephones to place orders at quick service restaurants.

Moreover, Ishikawa also fails to disclose or suggest that its headsets are adapted to be programmable by the user. Therefore, Ishikawa provides no motivation or suggestion to modify Ishikawa to include the infrared features disclosed in Ruppert that are used to program the headsets. Accordingly, for at least the above reasons, Ishikawa and Ruppert are not properly combinable.

II. Examiner Interview Summary


A telephone conference with the Examiner was conducted on August 30, 2004 by Kate DeVries Smith, with Joseph Lee also in attendance. The Examiner's courtesy in conducting the interview is very much appreciated. The issues addressed above in section I., subsection A and B were discussed. In summary, the Examiner agreed that the proposed amendments overcome Ishikawa, because Ishikawa fails to disclose a user activated lane change switch. Nonetheless, the Examiner indicated that the proposed amendments warrant additional prior art searching. No resolution was reached regarding the motivation to combine issues. The Examiner indicates that the motivation to combine issues will be considered in more depth upon the filing of this Amendment.

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes that an additional telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: Sept. 9, 2004



Katherine M. DeVries Smith
Reg. No. 42,157
KDS/JEL:sl

